

REMARKS

Prior to entry of this Amendment:

- Claims 1-34 were pending in the present application
- Claims 1-34 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-10 and 12-34 will be pending
- Claim 1 will be amended
- Claim 11 will be cancelled
- Claims 1, 25, 28, 31, 33, and 34 are independent claims

Applicants have amended Claim 1 for purposes of clarification by reciting what was implicit and by including matter from cancelled dependent Claim 11. No amendment was made for a reason related to patentability.

Examiner Interview

Initially, Applicants would like to that the Examiner for the interview conducted on October 18, 2004. The Examiner was extremely helpful in clarifying the objection to the drawings. In particular, the Examiner stated that while the figures as originally filed showed every feature of the broad independent claim, the Examiner wished to see additional method steps depicted for each dependent claim that contains an "if" statement. In response to this request, Applicants have replaced Figure 4 with a new Figure 4 which shows steps 405, 407 and 409.

Additionally, Applicants would also like to thank the Examiner for his openness to an additional interview to facilitate prosecution and comment on claim amendments which might be deemed allowable. The Examiner also acknowledged that the breadth of the prior art with respect to blackjack-like games was limited and felt that the present invention was patentable.

A. SECTION 102(e) REJECTIONS

Claims 1-4, 19 and 33 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,070,875 issued to Boylan et al. ("Boylan"). We respectfully traverse the Examiner's Section 102(e) rejection.

Claim 1 has been amended to include the limitations "*in response to said determining, generating an additional random outcome*" and "*wherein said random outcome is statistically independent of said hand of blackjack played prior to said push*" for purposes of clarification.

Boylan fails to teach or suggest *generating and additional random outcome* that is *statistically independent of said hand of blackjack played prior to said push*. Boylan arguably teaches "for each push hand, a further determining step is performed to determine whether a poker value of each push hand is greater than or less than a poker value of the hand of the banker." Column 2, lines 58-62. However, Boylan does not *generate an additional random outcome*, but instead determines "a poker value of each push hand" that has already been dealt. In other words, in Boylan the poker value is determined from an existing hand, not an *additional* outcome.

Further, even if the system of Boylan teaches the resolution of a blackjack hand that has resulted in a push, the system of Boylan is statistically *dependent* upon the blackjack hand as Boylan resolves the hands by determining "a poker value of each push hand" and the winner is determined by this value.

With respect to Claim 33, Boylan fails to teach or suggest "*transmitting a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack*." As stated above, Boylan determines "a poker value of each push hand" that has been dealt. Boylan does not teach or suggest "*transmitting*" as required by Claim 33.

Thus, Boylan does not teach or suggest *in response to said determining, generating an additional random outcome*, much less, *wherein said random outcome is statistically independent of said hand of blackjack played prior to said push* as recited in independent Claim 1. Boylan also fails to teach or suggest the limitation *transmitting a random outcome in response to said receiving*, as recited in independent Claim 33.

Consequently, the Examiner has failed to establish a *prima facie* case of anticipation with respect to the instant claims. As such, Applicants respectfully request reconsideration and withdrawal of the Section 102(e) rejection with respect to the instant claims.

Since each of Claims 2-4 and 19 are dependent from independent Claim 1, Claims 2-4 and 19 are patentable at least for the same reasons discussed above.

B. SECTION 103(a) REJECTIONS

Claims 5-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan, and further in view of U.S. Patent No. 5,362,064 issued to Lofink, et al. ("Lofink"). We respectfully traverse the Examiner's Section 103(a) rejection.

1. Factual Inquiries Required by *Graham* for Determination of Obviousness Under 35 U.S.C. § 103

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. U.S. Patent and Trademark Office policy is to follow Graham. Accordingly, examiners must apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 (8th ed., Rev. 1, Feb. 2003).

The four factual inquiries enunciated in Graham as a background for determining obviousness of a claim are as follows:

- (A) Resolving the level of ordinary skill in the pertinent art;
- (B) Determining the scope and contents of the prior art;
- (C) Ascertaining the differences between the prior art and the claims in issue; and
- (D) Evaluating evidence of secondary considerations.

M.P.E.P. § 2141. Some of these factual inquiries are discussed briefly below.

(a) **Level of Ordinary Skill in the Art**

Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) (“Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered.”). Some factors that may be considered are outlined at M.P.E.P. § 2141.03.

Without a factual determination of the level of ordinary skill in the art, obviousness cannot be assessed properly because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986).

Thus, a determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000) (citing Custom Accessories, 807 F.2d at 962).

(b) **Scope and Content of the Prior Art**

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. M.P.E.P. § 2141.01(a). Also, in order to avoid impermissible hindsight, the content of the prior art must be determined as of the time the invention was made. M.P.E.P. § 2141.01.

(c) **Differences between the Prior Art and the Claims**

Ascertaining the differences between the prior art and the claims at issue requires (i) interpreting the claim language, and (ii) considering both the invention and the prior art references as a whole. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02 (emphasis in original).

2. **Prima Facie Case of Obviousness**

In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious to the hypothetical

“person of ordinary skill in the art” when the invention was unknown and just before it was made. M.P.E.P. § 2142.

(a) Basic Requirements

To establish a *prima facie* case of obviousness for a claim, three basic criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
2. There must be some reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01.

(b) The Examiner Bears the Initial Burden of Factual Support

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142. The initial burden, therefore, is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. § 2142.

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

All underlying factual findings in an obviousness determination as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed

invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Dickinson v. Zurko, 527 U.S. 150, 144 L. Ed. 2d 143, 119 S. Ct. 1816 (1999); Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

3. The Examiner has Failed to Conduct the Required *Graham* Inquiries

We have carefully reviewed the Section 103 rejections of Claims **5-18** in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.

Specifically, the Examiner has neither

- (i) defined a level of ordinary skill in the art, nor
- (ii) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited references and the claims objectively.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

4. Request for Factual Support

In any subsequent Office Action asserting a Section 103 rejection, we respectfully request that the Examiner clearly indicate, with respect to each rejected claim, the support in the record for any findings under the required Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the

differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations.

In particular, we respectfully request that the Examiner define and submit evidence of the level of ordinary skill. Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

5. The Examiner has Failed to Meet the Basic Criteria for *Prima Facie* Obviousness

The Examiner has failed to make the requisite factual findings required under Graham (outlined above) and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

In addition, the Examiner has failed to make any assertion of a reasonable expectation of success with respect to any claim.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

Some criteria that have not been met with respect to particular claims are discussed further herein.

6. Claims 5-18

We respectfully submit that Claims 5-18 are not obvious in light of Boylan nor Lofink, either alone or in combination. First, neither Boylan nor Lofink teach or suggest all of the features of Claims 5-18.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of Claims 5-18.

(a) **The References Do Not Disclose All the Limitations of Claims 5-18**

As stated above with respect to the Section 102(e) rejection, Boylan fails to teach “in response to said determining, generating an additional random outcome.” As Boylan fails to teach a limitation of the independent claim from which Claims 5-18, the combination of Boylan and Lofink cannot teach every limitation of Claims 5-18 alone or in combination.

(b) **No Motivation to Combine the Cited References**

As best understood by us, the Examiner also asserts the following to be true with respect to Claim 5-18:

(a) It would have been obvious to one of ordinary skill in the art to modify Boylan in light of Lofink to provide for a feature of *displaying, initiating and using different random generated devices*

(b) The motivations for this modification in (c) above would be to provide game players a faster pace game while enticing participation from new game players

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (d) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (d) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

(i) **The Asserted Motivation is Not Shown in the Cited References**

We have carefully reviewed the Office Action issued in the present application, as well as the Boylan and Lofink references cited by the Examiner. We have failed to find a motivation anywhere in the evidence of record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise. The Examiner has cited to Lofink for the motivations to remove the “vig” and reduce the complexity of Baccarat. See Lofink, Column 5, lines 12-31. Nowhere in the references is the motivation to modify or combine the cited references in the manner suggested by the Examiner.

(ii) **The Cited References Teach Away from Each Other**

Boylan is not combinable with Lofink, because Lofink accomplishes the opposite of what is intended by Boylan. Namely, Boylan seeks to quickly eliminate ties, whereas Lofink seeks to create them, albeit in a different game. In fact, adopting the teachings of Lofink would create the very situations that Boylan seeks to avoid - ties.

Boylan arguably teaches: “The present invention is preferably played in the same manner as any value total wagering game with a bank, with the exception that no ‘push’ or ‘standoff’ hands result where the ante bet is returned to the player.” Column 2, lines 1-14. In contrast, Lofink arguably teaches:

Either of the above two versions could be modified by using devices other than card point totals to establish a "push" or "bar" situation for what would otherwise be a winning hand. For example, separate mechanical or electrical devices can be used to establish that a particular round of play of Baccarat would be a winning hand "bar" round, i.e. a normal winning hand would be barred from winning during that particular round of Baccarat and instead would become a "push" hand.

In one form of mechanical device, three dice are placed in a dice cup. Column 7, lines 23-33. Thus, Boylan teaches the importance of removing “push” or “standoff” hands. In contrast, Lofink, as quoted above, seeks to “establish a "push" or

"bar" situation for what would otherwise be a winning hand". In summary, the two references clearly teach away from each other.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of Claims 5-18. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of Claim 5-18 and request reconsideration and withdrawal of the Section 103(a) rejection with respect to the instant claims.

7. Claims 20-22 and 24

Claims 20-22 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan, in view of Lofink, and further in view of U.S. Patent No. 6,394,456 issued to Long ("Long"). We respectfully traverse the Examiner's Section 103(a) rejection.

We respectfully submit that Claims 20-22 and 24 are not obvious in light of Boylan, Lofink nor Long, either alone or in combination. First, Boylan, Lofink nor Long teach or suggest all of the features of Claims 20-22 and 24.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claims 20-22 and 24.

(a) The References Do Not Disclose All the Limitations of Claims 20-22 and 24 As stated above with respect to the Section 102(e) rejection and the Section 103(a) rejection of Claims 5-18, Boylan fails to teach "*in response to said determining, generating an additional random outcome.*" As Boylan fails to teach a limitation of the independent claim from which Claims 20-22 and 24 depend, the combination of Boylan, Lofink and Long cannot teach every limitation of Claims 20-22 and 24 alone or in combination.

(b) No Motivation to Combine the Cited References

For the reasons stated above with respect to Claims 5-8, Applicants assert that the Examiner has failed to provide a proper motivation to combine the references in the manner indicated.

8. Claims 25-32

Claims **25-32** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan, in view of Official Notice. We respectfully traverse the Examiner's Section 103(a) rejection.

(a) Official Notice

The Examiner's rejection of Claim **25-32** is thus based in part on unsupported general assertions of what was "the Examiner takes to be equivalent...to a plurality of separate or multiple hands as recited in Claims 25-32." [Office Action, page 10.] We respectfully traverse the Examiner's Official Notice of the recited features of claims **25-32**.

We note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The cited Boylan reference does not support the Examiner's broad assertions as to what is equivalent or obvious; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, we cannot properly determine the bounds of the prior art. Accordingly, we dispute that the subject matter asserted is "equivalent" at the time the invention was made, and request, for each of the claims (**25-32**), a reference to clarify the subject matter in more detail. MPEP 2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noted subject matter cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found

necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference** teaching.") (emphasis added).

A reference must be provided to show the scope and content of the prior art. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973).

Consequently, Applicants respectfully request references in support of the Examiner's assertion of what the "Examiner takes to be equivalent." If the Examiner cannot provide a reference in support of the assertion Applicants respectfully request reconsideration and withdrawal of the Section 103(a) rejection against Claims **25-32**.

9. Claim 34

Claim **34** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan, in view of Lofink. We respectfully traverse the Examiner's Section 103(a) rejection.

We respectfully submit that Claim **34** is not obvious in light of Boylan nor Lofink, either alone or in combination. First, neither Boylan, nor Lofink teach or suggest all of the features of Claim **34**.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim **34**.

(a) **The References Do Not Disclose All the Limitations of Independent Claim 34**

As stated above with respect to the Section 102(e) rejection and the previous Section 103(a) rejections, Boylan fails to teach “*in response to said determining, initiating a random outcome generator.*” As Boylan fails to teach a limitation of the claim, the combination of Boylan and Lofink cannot teach every limitation of Claim 34 alone or in combination.

(b) **No Motivation to Combine the Cited References**

As best understood by us, the Examiner also asserts the following to be true with respect to independent Claim and:

(a) It would have been obvious to one of ordinary skill in the art to modify Boylan in light of Lofink include *a random outcome generator and receiving an indication of a random outcome, the random outcome being statistically independent of the hand of the blackjack played prior to the push*

(b) The motivations for this modification in (c) above would be to determine the winner in the event of a tie

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (d) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (d) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

(i) **The Asserted Motivation is Not Shown in the Cited References**

We have carefully reviewed the Office Action issued in the present application, as well as the Boylan and Long references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise.

(ii) **The Cited References Teach Away from Each Other**

As stated previously, Boylan is not combinable with Lofink, because Lofink accomplishes the opposite of what is intended by Boylan. Namely, Boylan seeks to quickly eliminate ties, whereas Lofink seeks to create them, albeit in a different game. In fact, combining the teachings of both references would create the very tied situations that Boylan seeks to avoid.

Boylan arguably teaches: "The present invention is preferably played in the same manner as any value total wagering game with a bank, with the exception that no 'push' or 'standoff' hands result where the ante bet is returned to the player." Column 2, lines 1-14. In contrast, Lofink arguably teaches:

Either of the above two versions could be modified by using devices other than card point totals to establish a "push" or "bar" situation for what would otherwise be a winning hand. For example, separate mechanical or electrical devices can be used to establish that a particular round of play of Baccarat would be a winning hand "bar" round, i.e. a normal winning hand would be barred from winning during that particular round of Baccarat and instead would become a "push" hand.

In one form of mechanical device, three dice are placed in a dice cup. Column 7, lines 23-33. Thus, Boylan teaches the importance of removing "push" or "standoff" hands. In contrast, Lofink, as quoted above, seeks to "establish a "push" or "bar" situation for what would otherwise be a winning hand". In summary, the two references clearly teach away from each other. As Boylan cannot be combined with

Lofink, Long cannot be combined with the combination of Boylan and Lofink to arrive at the limitations of the instant claims

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of Claims **20-22** and **24**. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of Claim **20-22** and **24** and request reconsideration and withdrawal of the Section 103(a) rejection with respect to the instant claims.

C. OBJECTION TO THE DRAWINGS

The Examiner has objected to the drawings under 37 CFR 1.83(a) as failing to show every feature specified in the claims. While the Applicants disagree with the Examiner's objection to the figures, Applicants have submitted a replacement Figure 4 to comply with the Examiner's request. No new matter has been added.

Support for new step 405 can be found in the Specification at page 8, line 34 and Claim 2. Support for new step 407 can be found in the Specification at page 9, lines 2-3 and Claim 2. Support for new step 409 can be found in the Specification at page 9, line 8 and Claim 4.

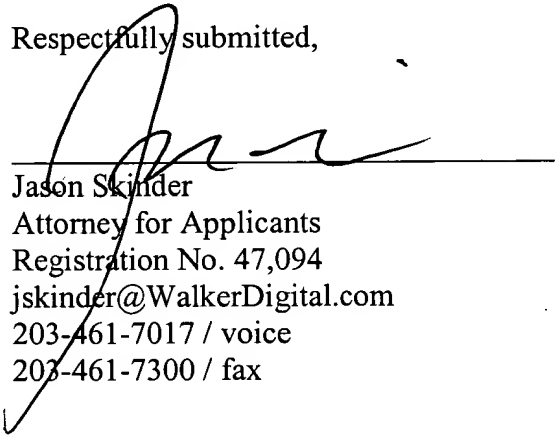
CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at jskinder@walkerdigital.com.

October 21, 2004
Date

Respectfully submitted,



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IN the FIGURES

Please replace Figure 4 with newly submitted Figure 4.